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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,336	10/29/2001	Robert Setbacken	8371/9	1535

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EXAMINER

LE, QUE TAN

ART UNIT PAPER NUMBER

2878

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039,336

Applicant(s)

SETBACKEN ET AL.

Examiner

Que T. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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This is in response to Applicants' Preliminary amendment filed October 29, 2001.

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicants fail to identify, in the reissue declaration, at least one specific error, in the specification and/or in at least one of original claims, and how it renders the original patent wholly or partially inoperative or invalid.

Claims 1-38 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 19 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Proper support for citations of "a clamping element comprising a slit" in claim 7, lines 3-4; and claim 19, line 4, and/or "said clamping device comprising an axial slit" in claim 31, lines 3-4 have not been found in the present specification. The feature of a "clamping element" and/or a "clamping device" has not been clearly disclosed or discussed in the present

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specification. Also, a clamping element/device having a slit has never been disclosed or discussed in the present specification. Note that the present specification has disclosed/discussed only "The second end of the pick-up shaft 2 ... has axially extending slits and an interior thread 8. If the pick-up shaft 2 is to be connected, ... the slitted area of the pick-up shaft is spread open radially which achieves a rigid radial clamping." (See column 2, lines 48-56 of the present specification). In addition, a proper support for the citation of "a clamping element comprising ... an opening in which said actuating element is inserted, wherein movement of said actuating element with respect to said slit causes said slit to radially spread open ... relative rotation" on lines 4-8, of claim 19, has not been found in the present specification. The present specification has never disclosed an actuating element which merely be inserted into an opening (of a clamping element"?" comprising a slit), wherein the movement of said actuating element causes the slit to radially spread open.

Claims 7, 19 and 31 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claims 7, 19 and 31 contain the features of "a clamping element" and/or "a clamping device" having a slit, and "an actuating element" which simply be inserted into an opening of a clamping element(?) having a slit in which the (inserting) movement of the actuating element causes the slit to radially spread open, which are considered new matter for the reasons set forth above.

Claims 7-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the citation of "an actuating element" and its performances, on lines 5-6, is vague. The actual relationship between the actuating element and the clamping element or clamping area has not been clearly defined. What exactly is the "clamping element" and/or the "clamping area"? It is unclear how and in what manner a rotatable contact(?) between the actuating element and the pick-up shaft "is operative to directly spread said slit" of the clamping element.

In claim 12, the antecedent basis of "said slit" on line 3 is unclear. Is it the same or different from the slit (of the clamping element) recited in the base claim 7?

In claim 19, the citation of a "clamping element comprising a slit" and its operation/performances, on lines 4-8, is vague because a structure relationship between the clamping element, the pick-up shaft, and the drive shaft has not been clearly defined. Also, the phrase "a clamping element comprising a slit ..., said clamping element forming, at least in part, an opening in which said actuating element is inserted" on lines 4-6 is unclear. How and in what manner is an opening formed? What exactly is the "clamping element"? Note that, the terminologies being used for identifying the elements/components/features of the claimed invention should be in consistent throughout the disclosure of the application. The antecedent basis/bases of "said pick-up shaft and drive shaft" is unclear.

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In claim 24, the further citation of the claim is similarly unclear as discussed in the claim 12 above.

In claim 31, the phrase "a clamping device fixed against relative rotation relative to a drive shaft of a drive unit" on lines 2-3 is vague in its given context. The mutual relationship between the elements/devices of the claimed invention is unclear.

Therefore, the intended scope of the invention is unclear.

The further citation of claim 33 is similarly unclear as discussed in the claims 12 and/or 24 above.

Claims 8-11, 13-18, 20-23, 25-30, 32 and 34-38 are indefinite because they include the indefiniteness of the claims on which they depend.

Claims 1-6 are allowable over the prior art of record because the prior art fails to teach an angle measuring system having a coding disk, a pick-up shaft, a drive shaft, wherein the pick-up shaft having axial slits in a clamping area which can be radially spread open by an actuating element comprising: a screw or actuating element having an exterior thread in the clamping area and which can be turned in the pick-up shaft; and a corresponding interior thread on the pick-up shaft in the clamping area and wherein the screw having an axially acting detent surface which is supported against an axial detent of the pick-up shaft during clamping.

Claims 7-38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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I) Feichtinger et al 5,758,427 disclose an angular position measuring system including a clamping device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Que T Le  
Primary Examiner  
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